

REMARKS/ARGUMENTS

I. Discussion of rejection of claims 1 - 11 under 35 USC §102(b) as being anticipated by U.S. Patent No. 5,417,432 to Dwyer.

Applicants respectfully point out, as the Examiner should be aware, for a reference to be a reference under any paragraph of §102, that reference, *by itself*, must teach each and every element of the claimed invention. That is not achieved by Dwyer by itself.

The Examiner cited Dwyer and noted that this patent discloses playing cards having a first suit of 26 cards each with a letter of the alphabet “A” to “Z” and a picture, and a second suit of 26 cards each with a letter of the alphabet “A” to “Z” and a picture, but varying in color of border design. This is correct.

In other words, the letter/picture of each of the 26 cards in the first suit is the same letter/picture of each of the 26 cards in the second suit. Thus, the two suits are the SAME, with the ONLY difference between the two suits being the color of the border design.

In contrast, applicants’ independent product claim 1, and thus due to incorporation by reference, all of dependent claims 2 – 11 which depend back to independent claim 1, require two DISTINCT suits where the first suit comprises threat cards and the second suit comprises tool cards.

The Examiner goes on to cite *Ex parte Breslow*, 192 USPQ 431 (Board of Appeals, 1975), for the proposition that the differences that reside in the meaning and information conveyed by printed matter on the cards are considered unpatentable differences. Applicants respectfully submit that the Examiner has misinterpreted *Ex parte Breslow*.

Rather, *Ex parte Breslow* involved an appellant's claimed combination card game/board game, where the prior art Mitchell patent also involved a combination card game/board game.

The claimed game had a board divided into stations indicative of jobs which require certain qualifications and pay certain salaries, and cards divided into job experience cards, job availability cards, and salary cards. Information on the cards was utilized to follow the game rules. A chance device was operated to determine the number of stations that a player moved the playing piece and the station landed on determined from which set of cards the player must draw. The directions printed on the card drawn determined what the player must do for the game to progress.

The prior art Mitchell game had a board, a chance device and sets of cards. The board was divided into stations and the chance device determined the station to which a player's playing piece was advanced. The station landed on (by color code) determined from which deck of cards the player would draw. The instructions on the card determined what the player must do for the game to progress.

Thus, the Board in *Ex parte Breslow* held that:

the relationship between the game board and cards of Mitchell is identical to that of appellant's game board and card and ... the printed matter on the game board and cards of appellant's game is insufficient to define any new functional relationship over that shown by Mitchell.... There is as much correlation between the sets or deck of cards and the stations of Mitchell as there are in appellant's board game. ... Any differences relate to the information or instructions conveyed by the printed matter and not in any structure per se.

In short, the function between the cards and the board in the Mitchell game was the same as the function between the cards and the board in appellant's claimed game.

In contrast, applicants' playing cards have significant structural differences in that the cards have *two different suits*, where the first suit has the structure of threat cards and the second suit has the structure of tool cards. However in Dwyer, there are two suits, but the cards of the first suit are the same as the cards of the second suit, with only a minor

variance in border color. Thus, the function between applicants' first suit and second suit is different from the function between Dwyer's first suit and second suit.

If applicants' two suits were the same cards, it would not be possible to play applicants' card game, namely for a player to tell a story based on both the threat card and the tool card. On the other hand, having the two suits be the same cards is the function of Dwyer, namely to teach children the alphabet by the children matching two cards with letter "A", two cards with letter "B", and so on.

Next, the Examiner cited *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), for the proposition that claimed printed matter should be given patentable weight because there was a functional relationship between the printed matter and the substrate. The Examiner then concluded that in the present case, there is no functional relationship between the substrate (applicants' cards) and the matter in question (applicants' legends and pictures) printed on the substrate. Specifically, the Examiner concluded:

The Applicant's [*sic*, Applicants'] cards and Dwyer's cards provide a substrate or support for the legends and pictures such that the legends and pictures can be displayed for the convenience of the players. Therefore, the Applicant's [*sic*, Applicants'] legends and pictures recited in claims 3 – 7 and 11 do not patentably distinguish from Dwyer's legends and pictures proposed by the Examiner.

*Applicants respectfully point out that the Examiner's conclusion [cards provide a substrate or support for the legends and pictures such that the legends and pictures can be displayed for the convenience of the players] is true of **all** card games, and if that were a reason for lack of patentability, then **no** card game would ever be patentable.*

Clearly, the Examiner's reason for lack of patentability is erroneous, as the Examiner has misinterpreted the meaning of *In re Gulack*.

Rather, *In re Gulack* stands for the proposition that differences between the claimed invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of printed matter. Applicants respectfully submit that the Examiner is ignoring the differences between applicants' claimed invention and

the card game of cited Dwyer merely because those differences reside in the content of printed matter.

Applicants have clearly explained the differences between their card game and the card game in Dwyer, and the Examiner is respectfully referred to applicants' discussion above.

Moreover, as pointed out above, applicants respectfully reiterate that, as the Examiner should be aware, §102 relates to anticipation, and thus, for a reference to be a reference under any paragraph of §102, that reference, *by itself*, must teach each and every element of the claimed invention.

The Examiner, *by his own admission*, has acknowledged that there are differences between applicants' card game and the card game disclosed in Dwyer. Hence, Dwyer cannot be a reference under §102(b).

Accordingly, the Examiner is respectfully requested to withdraw the rejection under §102(b) for anticipation of claims 1 – 11 with regard to U.S. Patent No. 5,417,431 to Dwyer.

II. Discussion of rejection of claims 12 - 27 under 35 USC §103(a) as being obvious over U.S. Patent No. 5,547,199 to Calhoun, in view of U.S. Patent No. 4,637,799 to Bouchal.

The Examiner noted that Calhoun discloses a method of playing a card game where the cards have a first suit of sentence cards and a second suit of picture cards, the two suits being separated. A player selects a sentence card and at least one picture card, and then must explain how the picture on the picture card relates to the sentence on the sentence card.

Applicants respectfully point out the Examiner ignored that Calhoun requires that the sentence on the sentence card and the picture on the picture card are *already predetermined to inherently relate to each other*, and thus, a player selects a sentence card and at least one picture card, and then must explain that predetermined relationship of the picture on the picture card to the sentence on the sentence card.

The Examiner also noted that Bouchal '799 discloses a card game where a player observes the legends and pictures on displayed cards, and uses them to tell a story.

Applicants respectfully point out the Examiner ignored that Bouchal '799 requires that the player arranges a plurality of picture cards in a matrix array that is a logical sequence so that the player can tell a story based on what the arrangement means.

In contrast, applicants' independent method claim 12, and thus due to incorporation by reference, all of dependent claims 13 - 26 which depend back to independent claim 12, and also independent method claim 27 require two DISTINCT suits where both are picture cards, i.e., the first suit comprises threat cards and the second suit comprises tool cards. There are no sentence cards. The player takes a threat card and a tool card, and the player makes up the sentences, i.e., tells a story, for the relationship of the two cards.

With applicants' method, the player's story how the card of the first suit (threat card) relates to the card of the second suit (tool card) is solely devised by the player, and not inherently predetermined as in Calhoun.

Furthermore, with applicants' method, there is no arranging of a plurality of picture cards into a matrix, as is done in the card game in Bouchal '799.

If Calhoun and Bouchal '799 were combined, then the resultant would be a matrix of cards with sentences such that the matrix of cards tells its own story. All the player would do is read the story from the matrix of cards, and there would be no need for creativity on the part of the player. This is a teaching away from applicants' claimed method. Furthermore, applicants respectfully point out that it well known law that it is improper to ignore certain teachings of the references, as the references must be considered as a whole with respect to the claimed invention as a whole.

Additionally with regard to applicants' method claims 13 and 17 - 20, the Examiner referenced *Ex parte Breslow* and *In re Gulack*. Applicants' above comments vis-à-vis these cases are incorporated here by reference.

Accordingly, the Examiner is respectfully requested to withdraw the rejection under §103(a) for obviousness of claims 12 - 27, with regard to U.S. Patent No. 5,547,199 to Calhoun, in view of U.S. Patent No. 4,637,799 to Bouchal.

CONCLUSIONS

Applicants respectfully submit that in view of the above comments, all claims are allowable, and the Examiner is respectfully requested to withdraw the various rejections under 35 USC §102(b) and under 35 USC §103(a).

Accordingly, applicants respectfully submit that the case is in condition for allowance and early allowance is earnestly solicited, and the Examiner is respectfully requested to allow all claims.

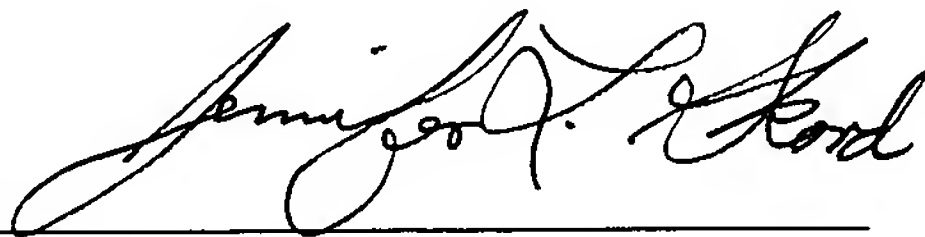
If the Examiner should have any questions of a minor nature after reading the above, the Examiner is respectfully requested to telephone the undersigned in order to attend to any such minor issues and obviate the issuance of another Official Action.

DEPOSIT ACCOUNT

Although, it is believed that no fee is due, the Commissioner is authorized to charge any deficiencies of payment associated with this Communication, or to credit any overpayment, to **Deposit Account No. 13-4365**.

Date: December 20, 2004

Respectfully submitted,

By: 
Jennifer L. Skord
Reg. No. 30,687

MOORE & VAN ALLEN, PLLC
430 Davis Drive, Suite 500
Morrisville, North Carolina 27560-6832
Phone: 919-286-8000
Facsimile: 919-286-8199